

REMARKS

Summary of the Final Office Action

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Publication JP-A-10-009235 to Atsuyoshi et al. ("*Atsuyoshi*") in view of JP-A-7-165256 to Seiji ("*Seiji*") and JP-A-8-199123 to Akira et al. ("*Akira*") and further in view of U.S. Patent 4,791,014 to West¹ ("*West*"), U.S. Patent 6,626,294 to Fujishima et al. ("*Fujishima*"), and U.S. Patent 2,743,445 to Lerner ("*Lerner*").

Summary of the Response to the Final Office Action

Applicant has amended claims 1 and 9. Claims 1-9 are pending. The amendments herein are similar to those in the Amendment under 37 C.F.R. § 1.116 filed February 6, 2009, which were deemed to raise new issues requiring further consideration and/or search.

The Rejections under 35 U.S.C. § 103(a)

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Atsuyoshi* in view *Seiji* and *Akira* and further in view of *West*, *Fujishima*, and *Lerner*. Applicant respectfully traverses the rejections for at least the following reasons.

First, although the Office Action fails to clearly set forth which rationale is used to support the finding of obviousness, Applicant believes the Office Action may be relying on Rationale E – “Obvious to Try.” See MPEP § 2143(E). To reject a claim based on this rationale, the Office Action must state, among other things, “a finding that at the time of the invention

¹ The Final Office Action refers to U.S. Patent 4,791,014 as being to “Libby.” However, West is the inventor for this patent. Also, in paragraph 4, the Final Office Action discusses “Libby ’856” while, presumably, the Final Office Action is discussing U.S. Patent 4,791,014. The Applicant assumes all discussion of “Libby” or “Libby ’856” in the Final Office Action is intended to refer to U.S. Patent 4,791,014 to West.

there had been a recognized problem or need in the art, which may include a design need or market pressure to solve a problem.” MPEP § 2143(E). Applicant submits that the Office Action has failed to make such a finding.

Second, with respect to independent claim 1, as amended, the arrangement of the tearable film only at a portion of the staple member corresponding to an inner side of crown portion of a C-shape staple is not merely a design choice, but is a choice made according to advantages. *See* MPEP § 716.02(f). As disclosed on page 6, line 21 – page 7, line 8 of the specification, such an arrangement allows for the film to be made inconspicuous by being pinched between the top portion and the sheet to be bound.

Third, the Final Office Action’s reliance on *West* is misplaced. The Final Office Action alleges that *West* “discloses that it’s well known in the art to provide the film adhered on the side of the staple that will become the inside portion of the bridge portion of the C-shape staple.” Applicant respectfully disagrees. Applicant can find no support in *West* for this assertion, and the Final Office Action provides none. Instead, *West*, at most, discloses providing a tape on the crowns of connected clips. *See, e.g.*, Figs. 1-3.

Fourth, the Final Office Action’s reliance on *Fujishima* is misplaced. The Final Office Action alleges that Figs. 4 and 6 of *Fujishima* “illustrate the film to be applied to the side of the staple that will become the inside of the C-shape staple.” Applicant respectfully disagrees. Applicant assumes the Final Office Action alleges pulling out tape 12 of *Fujishima* is a tearable film as claimed. Applicant respectfully disagrees. Independent claim 1, as amended recited a combination wherein “the number of staple members are connected by adhering with the tearable

film.” In *Fujishima*, staples 10a are not connected by adhering with pulling out tape 12. In fact, pulling out tape 12 is wound only one round on the roll staple body. *Fujishima*, col. 2, ll. 21-23. Instead, the function of the pulling out tape 12 is to provide a means by which the leading end portion of the roll staple body 11 can be extended in a sheet shape. *Fujishima*, col. 3, l. 65 – col. 4, l. 10. Accordingly, pulling out tape 12 is not a tearable film as claimed.

Finally, with respect to independent claim 1, as amended, *Lerner* fails to disclose a tearable film that “is adhered to a staple member only at a center portion of the staple member which does not constitute a leg after the staple member is formed.” Instead, *Lerner* discloses an elastic tape F which adheres to the leg portions of staple elements SE. *See, e.g., Lerner*, Figs. 5 and 6.

For at least the above reasons, the Final Office Action has failed to establish prima facie obviousness. Accordingly, Applicant respectfully requests the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn. Further, Applicant asserts that claims 2-9 are allowable at least because of their respective dependencies from independent claim 1, as amended, and the reasons set forth above.

Response to Advisory Action

The Advisory Action alleges that “[a]s regards claim 9, it’s examiner’s position that one of ordinary skill in the art should recognize limitation of claim 9 as being clearly and explicitly taught upon review of the Figures of the prior art relied on.” Presumably the Advisory Action is referring to the feature of original claim 9 that, by this Amendment, has been incorporated into independent claim 1. Applicant has modified this feature to recite “the tearable film is adhered

to a staple member only at a center portion of the staple member which does not constitute a leg after the staple member is formed.” The Advisory action relies on Fig. 1 of *Atsuyoshi* for support. Applicant respectfully disagrees. Fig. 1, at most, discloses a film 12 on a side of a band shape body 11 formed of straight staples 1. However, Fig. 1 does not disclose the extent to which the film 12 covers each staple 1. In other words, Fig. 1 does not disclose that film 12 is adhered to a staple 1 only at a portion of the staple 1 that does not constitute a leg after the staple member is formed.

The Advisory Action alleges that “it’s clear that claim 9 does not explicitly define the staple as having leg(s) without terable film on them since the claim is phrased functionally in terms of some later intended use of the staple.” The Advisory Action purports to identify what is not defined by the claims. Applicant submits that what is defined by the structural features of the claims is patentable over the art of record.

The Advisory Action alleges that “[t]he claim explicitly requires a straight staple as is shown in fig 1 of the reference.” Applicant submits that dependent claim 9 recites a staple member that is an unformed staple in a straight shape. However, claim 1 recites no such feature.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration of the application, withdrawal of all rejections, and the timely allowance of all pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants’ undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: March 25, 2009

By: 

Robert J. Goodell

Registration No. 41,040

CUSTOMER NO. 009629

MORGAN, LEWIS & BOCKIUS LLP

1111 Pennsylvania Avenue, N.W.

Washington, D.C. 20004

202.739.3000